C. REMARKS

Claims 8 and 9 are amended. Amendments to these claims are fully supported by the original specification and no new matter has been introduced.

Claim Rejections – 35 U.S.C. § 102(b)

Claims 1-3 and 5-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Amro et al., U.S. Patent No. 5,757,370 (hereinafter "Amro"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksma*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because the Examiner does not show that Amro teaches or suggests each an every element of the claims 1-3 and 5-9 or enables each and every element of these claims, claims 1-3 and 5-9 are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

As will shown below, Amro does not teach or suggests the method, computer system, and computer program as claimed in the present application. Claims 1-3 and 5-9 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually, and requests reconsideration of claims 1-3 and 5-9.

Claims 1, 6 and 8

Concerning Examiner's rejection of claims 1, 6, and 8, Applicants respectfully submit that Amro does not anticipate the invention of Applicants claims 1, 6, and 8 because Amro does not teach expressly or inherently the elements of claims 1, 6, and 8 or enable the elements of claims 1, 6, and 8. Specifically, Amro does not teach or enable the following claimed elements in method claim 1, and similar elements in system claim 6 and computer program claim 8:

> "in response to receiving a designated user action, displaying the list of identified document components", and
>
> "in response to receiving a user selection of one of the identified document components within the list, displaying another portion of the document containing the selected identified document component."

In the Office Action, the Examiner asserted that "Amro discloses this limitation in that the object location apparatus displays in a mini window an outline for the HTML document in response to the user pressing and holding the second mouse button down over the elevator in the scroll bar" (Office Action, Page 4). Applicants respectfully traverse Examiner's assertion, in that this characterization of Amro is not well founded. Amro teaches "[a]t 440, in response to the user pressing and holding the second mouse button down over the elevator, the GUI displays in a mini window the outline for the page currently represented by the position of the elevator" (Col. 4, lines 32-36)(emphasis added). Thus, contrary to the Examiner's characterization that Amro "displays in a mini window an outline for the HTML document", Amro actually displays in a mini window the outline for the page currently represented by the position of the elevator. In contrast, Applicants' claimed invention displays the list of identified document components, wherein the list of identified document components is created in response to parsing the document. Applicants' invention displays the list of identified document components and not just the components of the current page represented by the position of the elevator. In addition, Amro teaches away from Applicants' claimed invention by teaching that "the user can view the

box(cs) in the mini window to determine what type of object/text resides in that page" (Col. 4, lines 44-46) (emphasis added). Thus, Amro teaches away from "displaying the list of identified document components" as claimed by Applicants.

Concerning the third element in claim 1, Applicants submit that Amro does not teach "in response to receiving a user selection of one of the identified document components within the list, displaying another portion of the document containing the selected identified document component" as claimed by Applicants. In the Office Action, the Examiner asserted that "Amro discloses this limitation in that the object location apparatus removes the mini window and scrolls the HTML document to the object corresponding to the position of the elevator in the scroll bar in response to the second mouse button being released" (Office Action, Page 4). Applicants respectfully traverse Examiner's assertion, in that this characterization of Amro is not well founded. At the cited reference, Amro teaches:

> "At 430, the GUI displays the compound document, scroll bar, and elevator within window 300. The GUI sizes the elevator in accordance with the size of the document. At 440, in response to the user pressing and holding the second mouse button down over the elevator, the GUI displays in a mini window the outline for the page currently represented y the position of the elevator. Additionally, other information could be displayed in the mini window, such as the page number. At 450, in response to the second mouse b utton continuing to be held down over the elevator and the uer dragging the elevator upward or downward, the GUI then dynamically searches through RAM for the database table for the information needed to display the outline of the page corresponding to the position of the elevator within the scroll bar. The GUI then dynamically searches the database table for the information needed to display the outline of the page in the mini window next to the elevator. Therefore, the user can view the box(es) in the mini window to determine what type of object/text resides in that page. At

> 460, in response to the second mouse button being released, the GUI removes the mini window and scrolls the compound document to the page corresponding to the position of the elevator in the scroll bar. (Col. 4, lines 40-50)

Nowhere in Amro is there any teaching or suggestion that would allow receiving a user selection of any content within the mini window, much less "in response to receiving a user selection of one of the identified document components within the list, displaying another portion of the document containing the selected identified document component" as claimed by Applicants. The purpose and use of mini window taught by Amro is such that "the user can view the box(es) in the mini window to determine what type of object/text resides in that page" (Col. 4, lines 44-46), and not to select any box in the mini window. Thus, Amro does not teach Applicants claimed invention. Furthermore, Amro teaches away from Applicants' claimed invention by teaching "[a]t 460, in response to the second mouse button being released, the GUI removes the mini window and scrolls the compound document to the page corresponding to the position of the elevator in the scroll bar" (Col. 4, lines 46-50) (emphasis added), thus teaching away from "receiving a user selection of one of the identified documents components" as claimed by Applicants. Not only does Amro not receive a user selection in the mini window, but also teaches away from selecting any of the components within the mini window, by simply scrolling the document to the page corresponding to the position of the elevator when the second mouse button is released. Applicants' claimed invention instead requires a selection of one of the identified document components within the list, and then displays another portion of the document containing the identified document component. Furthermore, Amro teaches away from displaying another portion of the document containing a document component in response to a selection of one of the identified document components within the list by teaching that "the GUI removes the mini window and scrolls the compound document to the page corresponding to the position of the elevator" (Col. 4, lines 47-50) (emphasis added), thus scrolling to the page that corresponds to the position of the elevator and not as result of a selection of a document component within the mini window.

Thus, in light of the above claim elements not anticipated by Amro in claim 1, and similar elements in claims 6 and 8, Applicants respectfully request allowance of claims 1, 6 and 8.

Claims 2, 7 and 9

Responsive to Examiner's rejection of Claims 2, 7, and 9, Applicants submit that Amro does not teach "displaying the list of identified document components" where the list is of the identified document components as claimed by the Applicants in independent claims 1, 6, and 8. Amro teaches "[m]ini window 330 displays an 'outline' (described herein) of the compound document's page corresponding to the position of elevator 310 within scroll bar 320." (Figure 3, and Col. 3, 23-26). Nowhere does Amro teach displaying the list of the identified document components but instead teaches displaying an "outline" of the page and not the document. In describing the "outline", Amro teaches "the GUI can create a reduced representation (i.e., outline) of the text and objects within a particular page, and then display that reduced representation in a mini window." (Col. 3, lines 37-40) (emphasis added). Thus, Amro teaches displaying a reduced representation of a page and not the list of identified document components as claimed by Applicants. Amro further reinforces the teaching of displaying only "pages" by teaching that "one skilled in the art recognizes that there are other means for displaying the reduced representation of the pages" (Col. 3, lines 40-42) (emphasis added). In addition, Amro teaches away from Applicants' claimed invention by requiring the display of "reduced representation of pages" and not the list that contains the identified document components.

Applicants further submit that Amro does not teach "displaying another portion of the document containing a selected identified document hyperlink in response to receiving a different user selection of one of the identified hyperlinks" as claimed by Applicants. As argued above with respect to claims 1, 6, and 8, Amro also teaches away from Applicants' claimed invention by teaching "[a]t 460, in response to the second mouse button being released, the GUI removes the mini window and scrolls the compound document to the page corresponding to the position of the elevator in the scroll bar" (Col. 4, lines 46-50) (emphasis added), thus teaching away from

displaying another portion a document by selecting one of the identified hyperlinks included in the list of document components as claimed. In fact, Amro does not teach selecting anything from the mini-window, thus, Applicants invention can not be found in Amro.

Therefore, Applicants respectfully request allowance of claims 2, 7, and 9, by submitting that claims 2, 7, and 9 are not anticipated by Amro. Dependent claims 2, 7, and 9, depend from corresponding claims 1, 6, and 8, and contain all the limitations of their respective parent claims. As argued above with respect to claims 1, 6, and 8, Applicants submit that claims 1, 6, and 8, are patentable. Accordingly, Applicants submit that dependent claims 2, 7, and 9 are also patentable.

Claim 3

Responsive to Examiner's rejection of claim 3, Applicants submit that Amro does not anticipate Applicants' claimed invention. As argued above, Applicants submit that Amro does not anticipate claim 1 and is patentable. Claim 3 depends from claim 1, and contains all the limitations of claim 1. Therefore, Applicants submit that claim 3 is also patentable, and respectfully request allowance of claim 3.

Claim 4

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuppusamy et al., U.S. Patent No. 6,769,096, in view of Amro, and further in view of Sotomayor, U.S. Patent No. 5,708,825. As will be shown below, neither Kuppusamy, Amro, nor Sotomayor, alone or in combination teach or suggest Applicants' claimed invention.

Kuppusamy does not teach or suggest, and instead teaches away from, in response to parsing the document, creating a list of identified document components, and storing the list in a cache

Kuppusammy does not teach or suggest "in response to parsing the document, creating a list of identified document components, and storing the list in a cache" as claimed by Applicants.

Kuppusamy teaches "at 604, an entry is created in the TOC document" (Col. 10, Line 44) and "at 602, a frameset and the TOC document are created" (Col. 10, Lines 35-36), and that "once the frameset is created, the contents of both documents can be saved as HTML documents in an Internet browser-readable format" (Col 10, Lines 8-10), and that "saving documents in HTML language is known in the art of word processors." Thus, Kuppusamy teaches that the contents in the TOC document are stored using conventional document saving techniques, and Kuppusamy does not teach storing the entries in a cache as in the claimed element "in response to parsing the document, creating a list of identified document components, and storing the list in a cache".

In contrast, the Applicants claim "in response to parsing the document, creating a list of identified document components, and storing the list in a cache" wherein the results of the parsing (i.e., the list of headings, hyperlinks, image descriptions, or other document components) are stored in a cache and not as conventional HTML documents. Thus, Kuppusamy does not teach or suggest Applicants' claimed invention.

Furthermore, Kuppusamy teaches that the integrity of the original document is not preserved wherein "as part of creating the hyperlink entry, an anchor is *inserted into the target document* at a location proximate to the preselected heading" (emphasis added) (Col 3, lines 19-22). Thus, the original long document is modified via the teaching by Kuppusamy. In contrast, the subject matter document of the elements in the Applicants' claim is the instant "long document from a server", and not the document that is modified by having an "anchor [that] is inserted into the target document" as taught by Kuppusamy.

Furthermore, Kuppusamy teaches "an anchor is inserted into the target document" (Col 3, Line 20) wherein a frameset contains "a target document in a second frame" (Col 3, Line 12), and "once the frameset is created, the contents of both documents can be saved as HTML documents" (Col 10, Lines 8-10), thus, Kuppusamy teaches that the contents in the updated target document are stored using conventional document saving techniques, and Kuppusamy does not teach storing the entries in a cache as in the claimed element "in response to parsing the document, creating a list of identified document components, and storing the list in a cache".

In addition, by teaching that the frameset and the TOC as HTML documents using conventional saving techniques as is known in the art of word processors, Kuppusamy teaches away from Applicants claimed invention wherein Applicants claim saving the list of identified document components in a cache.

Amro does not teach or suggest, and instead teaches away from, "in response to receiving a designated user action, displaying the list of identified document components"

Applicants submit that Amro does not teach or suggest "in response to receiving a designated user action, displaying the list of identified document components", and instead teaches away from Applicants' claimed invention. As demonstrated in Applicants' response with respect to claim 1, Applicants have demonstrated that Amro does not teach or enable Applicants' claimed invention.

Applicants further submit that Amro does not teach or suggest Applicants' invention, and instead teaches away from Applicants' claimed invention by teaching that "the user can view the box(es) in the mini window to determine what type of object/text resides in that page" (Col. 4, lines 44-46) (emphasis added). By allowing the user to view only the object/text that resides in that particular page, and not the list that contains the identified document components, Amro teaches away from "displaying the list of identified document components" as claimed by Applicants.

Amro does not teach or suggest, and instead teaches away from "in response to receiving a user selection of one of the identified document components within the list, displaying another portion of the document containing the selected identified document component"

Applicants submit that Amro does not teach or suggest "in response to receiving a user selection of one of the identified document components within the list, displaying another portion of the document containing the selected identified document component", and instead teaches away from Applicants' claimed invention. As demonstrated in Applicants' response with

respect to claim 1, Applicants have demonstrated that Amro does not teach or enable Applicants' claimed invention.

Applicants further submit that Amro does not teach or suggest, and instead teaches away from Applicants' claimed invention by teaching that "[a]t 460, in response to the second mouse button being released, the GUI removes the mini window and scrolls the compound document to the page corresponding to the position of the elevator in the scroll bar" (Col. 4, lines 46-50) (emphasis added), thus teaching away from "receiving a user selection of one of the identified documents components" as claimed by Applicants. Not only does Amro not receive a user selection in the mini window, but also teaches away from selecting any of the components within the mini window, by simply scrolling the document to the page corresponding to the position of the elevator when the second mouse button is released. Applicants' claimed invention instead requires a selection of one of the identified document components within the list, and then displays another portion of the document containing the identified document component. Furthermore, Amro teaches away from displaying another portion of the document containing a document component in response to a selection of one of the identified document components within the list by teaching that "the GUI removes the mini window and scrolls the compound document to the page corresponding to the position of the elevator" (Col. 4, lines 47-50) (emphasis added), thus scrolling to the page that corresponds to the position of the elevator and not as result of a selection of a document component within the mini window.

The combination of Kuppusamy and Amro is improper

Applicants submit that the combination of Kuppusamy and Amro also does not teach or suggest Applicants' claimed invention because the combination of Kuppusamy with Amro would result in Kuppusamy not operating according to its intended purpose and there is no reasonable expectation of success in the proposed combination Of Kuppusamy with Amro. Similarly, the combination of Amro with Kuppusamy would render Amro unsuitable for operating according to its intended purpose. As has been demonstrated above, Kuppusamy teaches that the contents in the updated target document are stored using conventional document saving techniques. Amro,

on the other hand teaches that "the GUI dynamically searches through RAM for the page corresponding to the position of the elevator in the scroll bar" (Col. 4, lines 47-50). Furthermore, Amro teaches that "the GUI loads every page of the compound document from, for example, a had disk drive, into RAM 214. Once in RAM, at 420, the GUI scans each line of each page for specific indicators" (Col. 3, lines 60-63). Thus, Kuppusamy's teaching requires the contents to be saved in a conventional file, thus it can not operate with the teaching of Amro where the specific indicators (i.e., headers and trailers – Col. 3, lines 63, 64) reside in RAM instead. Thus the combined teachings of Kuppusamy and Amro renders both Kuppusamy and Amro unsuitable for their intended purpose.

Furthermore, the combination of Kuppusamy and Amro is improper because Kuppusamy teaches that "the user can easily navigate through the target document by triggering links in the TOC document corresponding to the heading which the user desires to be in the active window of the target document' (Col. 4, lines 41-45). On the other hand, the purpose and use of mini window taught by Amro is such that "the user can view the box(es) in the mini window to determine what type of object/text resides in that page" (Col. 4, lines 44-46), and not to select any box in the mini window. Thus, Kuppusami's teaching requires triggering of links in the TOC document but can not operate with the teaching of Amro where the mini window is used only to view the contents of the mini window without any triggering of links in the mini window. Thus the combined teachings of Kuppusamy and Amro renders both Kuppusamy and Amro unsuitable for their intended purpose.

The combination of Kuppusamy and Amro and Sotomayor is improper

The examiner admitted that Kuppusamy, in view of Amro fails to expressly disclose "identified document components that are displayed in an alphabetical order" as claimed by Applicants, but that "Sotomayor teaches this limitation "on order to facilitate ordering of the document components in a multipage document so that a particular part of the document is easily located in the list" (Office Action, page 16). Applicants submit that the combination of Kuppusamy and Amro is improper as it renders both Kuppusamy and Amro unsuitable for their

intended purpose, thus, their combination with Sotomayor does not adequately remedy that unsuitability.

Therefore, Applicants submit that claim 4 is patentable for the foregoing reasons, and respectfully request allowance of claim 4.

Claim 5

Responsive to Examiner's rejection of claim 5, Applicants submit that Amro does not teach "removing the list from being displayed if a subsequent user action outside of the displayed list area is received" as claimed by Applicants. The Examiner asserted that "Amro discloses this limitation in that it expressly recites that, when the user releases the second mouse button, the mini window is removed; this implies that the min window is removed whenever the subsequent user action is inside or outside the mini window" (Office Action Page 6). Applicants respectfully traverse the Examiner's assertion, in that Amro never teaches "the list being displayed" wherein the claimed list is "of the identified document components", but instead Amro teaches a "mini window" being displayed, wherein Amro's mini window is "a reduced representation (i.e., outline) of the text and object within a particular page" (Col. 3, lines 36-38) (emphasis added), and the content Amro displays is "that reduced representation in a mini window" (Col. 3, lines 39-40). Thus, Applicants submit that Amro does not anticipate Claim 5.

In addition, Applicants submit that Amro does not anticipate Applicants' claimed invention because as argued above, Amro does not anticipate claim 1 and is patentable. Claim 5 depends from claim 1, and contains all the limitations of claim 1. Accordingly, Applicants submit that claim 5 is also patentable, and respectfully request allowance of claim 5.

Conclusion

In light of the above responses and remarks, the rejection of claims 1-9 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-9 in light of the present amendments and remarks is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

Marilyn Smith Dawkins
Attorney for Applicants
Registration No. 31,140
(512) 823-0094